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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/252,574

02/18/99

WALKER

J

3553-4018

EXAMINER

TM02/1205

MORGAN & FINNEGAN LLP
345 PARK AVENUE
NEW YORK NY 10154

ROSEN, N

ART UNIT

PAPER NUMBER

2165

DATE MAILED:

12/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/252,574

Applicant(s)

WALKER ET AL.

Examiner

Nicholas D. Rosen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 1999.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-25 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 11, 13-16, 26-31, 33-35, 38 and 40-50 is/are rejected.
- 7) ☒ Claim(s) 5, 9, 10, 12, 32, 36, 37 and 39 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 8.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____.

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Claims 1-50 have been examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley. Hensley discloses an allocation method in a buyer-driven system. Hensley does not expressly disclose identifying one of at least two sellers as a priority seller, but by beginning with a particular seller, while knowing that there was another shop down the street (second page, ninth paragraph), Hensley implicitly identified that seller as a

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priority seller. Hensley discloses providing the priority seller with a first look opportunity to satisfy a conditional purchase offer (first page).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley. Hensley does not expressly disclose that he provided another of at least two sellers with a second look opportunity to satisfy the conditional purchase offer, but does state that it would have been possible to do so, and that this was widely known (second page, paragraphs, four, five, and nine). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to provide another of the at least two sellers with a second look opportunity to satisfy the conditional purchase offer, for the obvious advantage of giving the buyer another chance to obtain something that the priority seller was unable or unwilling to sell at a price acceptable to the buyer.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley as applied to claim 1 above, and further in view of Donner et al. (European Patent Application 0 512 702 A2). Hensley does not expressly disclose binding the buyer to the conditional purchase offer, but Donner et al. disclose this (page 3, lines 2-8). (See also page 6, lines 3-18, for more on conditional purchase offers in Donner et al.) Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to bind the buyer to the conditional purchase offer, for the obvious advantage of assuring the seller that responding to the conditional purchase offer would be worth his time and trouble.

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Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley. Hensley discloses notifying the buyer that the conditional purchase offer will not be satisfied (by a head shake, first page; admittedly the notification was withdrawn, but the buyer was nonetheless notified).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley as applied to claim 1 above, and further in view of Donner et al. Hensley does not disclose that one of the at least two sellers is an agency-based seller, but Donner et al. teach that sellers can be agency-based sellers (page 3, lines 2-8). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to have a seller be an agency-based seller, for the obvious advantage of enabling business to be conducted without the need to contact the seller.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley. Hensley discloses that the seller was a broadcast-based seller.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley as applied to claim 1 above, and further in view of Donner et al. Hensley does not expressly disclose that the conditional purchase offer is a binding conditional purchase offer, but Donner et al. teach this (page 3, lines 2-8). (See also page 6, lines 3-18, for more on conditional purchase offers in Donner et al.) Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to make the conditional purchase offer a binding conditional purchase offer,

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for the obvious advantage of assuring the seller that responding to the conditional purchase offer would be worth his time and trouble.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley. Hensley does not disclose assigning a random number to each of the at least two sellers, and using the random number to identify the priority seller. However, official notice is taken that it is well known to assign random numbers to decide who shall have priority. (The Selective Service system used until 1973 is one example. Drawing straws, rolling dice, cutting cards, etc., to decide who enjoy some privilege or perform some task are other examples.) Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to assign and use random numbers to identify the priority seller, for the obvious advantages of assuring potential sellers that they would have an equal chance at getting business, and to assure potential buyers that they would have equal chances of being assigned any potential seller as a priority seller, rather than, for example, being steered to a high-priced seller in collaboration with the operator of the system.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley as applied to claim 1 above, and further in view of Donner et al. Hensley does not expressly determining a buyer preference metric for each of the at least two sellers, and using the buyer preference metric to identify at least one of the at least two sellers as the priority seller, but Donner et al. teach doing so (page 9, line 16, through page 10, line 41). Hence, it would have been obvious to one of ordinary skill in the art of commerce

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at the time of applicant's invention to determine and use a buyer preference metric, for the obvious advantage of steering the buyer to a seller who best matches the buyer's wants.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley. Hensley discloses providing an advantage to the one of at least two sellers identified as the priority seller, namely that the priority seller had the opportunity to make a profit on the sale of a pair of sandals to the buyer, an opportunity which other sellers did not have.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley. Hensley does not disclose determining whether more than one seller price will satisfy the conditional purchase offer, and selecting the highest seller price. However, official notice is taken that it is well known for sellers to prefer to sell higher-priced goods and services if possible, and to steer potential buyers toward higher-priced goods, which are typically shown first. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to determine whether more than one seller price would satisfy a conditional purchase offer, and to select the highest seller price, for the obvious advantages of enjoying the greater profits typically resulting from the sale of higher-priced goods and services, and leaving the lower-priced goods and services available for sale to customers only willing or able to pay a lower price.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley. Hensley discloses that he started off to determine whether there were other sellers that

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could satisfy the conditional purchase offer, and to perform a low price search of the other sellers, before this was rendered unnecessary by the priority seller's decision to satisfy the conditional purchase offer.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley in view of Donner et al. (European Patent Application 0 512 702 A2). Hensley does not expressly disclose identifying one of at least two sellers as a priority seller, but by beginning with a particular seller, while knowing that there was another shop down the street (second page, ninth paragraph), Hensley implicitly identified that seller as a priority seller. Hensley discloses providing the priority seller with a first look opportunity to satisfy a conditional purchase offer (first page). Hensley does not disclose a data storage device for storing relevant information, or a processor for carrying out the method, but Donner et al. teach these (page 2, line 31, through page 3, line 8). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to use a data storage device and processor to carry out the method disclosed by Hensley, for the obvious advantage of avoiding human effort.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley and Donner et al. as applied to claim 26 above. Donner discloses communication ports for communicating with the sellers and buyers (page 2, line 33). Hence it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to include a communications port, for the obvious advantage of

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communicating information to enable business to be transacted between people who are not in the same room together.

Claims 28-31, 33-35, 38, 40, 41, 42, and 43 are parallel to claims 1-4, 6-8, 11, 13, 14, 15, and 16, respectively, and therefore rejected on the same grounds.

Claims 44, 45, and 46 are parallel to claim 26, and therefore rejected on the same grounds.

Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Donner et al. (European Patent Application 0 512 702 A2). Donner et al. disclose a method for allocating buyer offers to sellers, comprising: receiving from a buyer a conditional purchase offer including a condition and a price, (page 6, lines 3-18); identifying, based on a predetermined metric, one of at least two sellers as a priority seller (page 9, line 18, through page 10, line 41); providing said purchase offer to the priority seller (page 9, lines 18-38); and, if said priority seller does not fill the conditional purchase offer, selecting a second seller, and providing the conditional purchase offer to the second seller (page 10, lines 4-8). Donner et al. do not disclose receiving from a buyer a financial account identifier, and authorization upon the fulfillment of a condition to use said financial account identifier to pay said price, but official notice is taken that it is well known to receive financial account identifiers (e.g., credit card numbers) from buyers,

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with authorization to use the financial account identifier to pay a price upon fulfillment of appropriate conditions (such as providing the goods that a buyer has ordered). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to receive a financial account identifier and authorization to use it upon fulfillment of a condition, for the obvious advantage of conveniently arranging for payment.

Likewise, Donner et al. do not disclose, if the priority seller fills the conditional purchase offer, using the financial account identifier to compensate the priority seller, but, as noted above, the use of financial account identifiers (e.g. credit card numbers) is well known, and held to be an obvious way of conveniently paying sellers.

Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Donner et al. as applied to claim 47 above. Donner et al. do not disclose that the metric is selected from the group comprising total market share, relevant market share, random numbers, and buyer preference. However, official notice is taken that it is well known to assign random numbers to decide who shall have priority. (The Selective Service system used until 1973 is one example. Drawing straws, rolling dice, cutting cards, etc., to decide who enjoy some privilege or perform some task are other examples.) Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to assign and use random numbers to identify the priority seller, for the obvious advantages of assuring potential sellers that they would have an equal chance at getting business, and to assure potential buyers that they would have equal

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chances of being assigned any potential seller as a priority seller, rather than, for example, being steered to a high-priced seller in collaboration with the operator of the system.

Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Donner et al. as applied to claim 47 above. Donner et al. disclose keeping sellers' identities anonymous from said buyer until the conditional purchase offer is filled (page 9, lines 34-38).

Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Donner et al. as applied to claim 47 above. Donner et al. disclose conditional offers including a flexible term that may be specified by a seller (page 6, lines 9-18; page 10, lines 9-41).

Allowable Subject Matter

Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 32 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Neither Hensley nor any other prior art of record teaches or reasonably suggests an allocation method in a buyer-driven system which includes, before

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identifying one of at least two sellers as a priority seller, determining which of at least two sellers could satisfy the conditional purchase offer. In Hensley, a seller is identified as a priority seller, and provided with a first look opportunity to satisfy a conditional purchase offer, but there is no indication that it was first determined whether the seller could satisfy the conditional purchase offer.

Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 36 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Neither Hensley, the closest prior art of record, nor any other prior art of record teaches or reasonably suggests an allocation method in a buyer-driven system wherein identifying one of at least two sellers as a priority seller includes: determining a number of first look opportunities due to the at least two sellers; determining a number of first look opportunities given to the at least two sellers; and identifying one of the at least two sellers with the largest deficiency between opportunities given and opportunities due as the priority seller. It is known in general to have people take turns, with the goal that each receive his fair share, but a detailed application to allocating first look opportunities in a buyer driven system is not known.

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Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 37 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Neither Hensley, the closest prior art of record, nor any other prior art of record teaches or reasonably suggests an allocation method in a buyer-driven system wherein identifying one of at least two sellers as a priority seller includes: determining a percentage of first look opportunities due to the at least two sellers based on an adjusted market share; determining a number of first look opportunities given to the at least two sellers; and identifying one of the at least two sellers with the largest deficiency between opportunities given and opportunities due as the priority seller. It is known in general to have people take turns, with the goal that each receive his fair share, but a detailed application to allocating first look opportunities in a buyer driven system is not known.

Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Claim 39 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Neither Hensley, the closest prior art of record, nor any other prior art of record, teaches or reasonably discloses an allocation method in a buyer-driven system wherein identifying one of at least two sellers as a priority seller includes determining a market share for each of the at least two sellers; and identifying one of the sellers having the largest market share that could also satisfy the conditional purchase offer as the priority seller.

Claims 17-25 are allowed.

The following is an examiner's statement of reasons for allowance: The closest prior art of record, Hensley, discloses identifying a seller as a priority seller, providing that seller with a first look opportunity to satisfy a purchase offer, identifying another seller as a second look opportunity seller, and, at least by implication, searching the market to determine which of a plurality of sellers can satisfy a conditional purchase offer. However, neither Hensley nor any other prior art of record teaches or reasonably suggests identifying a seller as a first look opportunity seller based on relative market share in a relevant market and number of first look opportunities provided as compared to number of first look opportunities due.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lupien et al. (U.S. Patent 5,101,353) disclose an automated system for providing liquidity to securities markets.

Johnson et al. (WO 00/42547) disclose a method and system for providing lists of merchants that provide particular products and services to customers, and for receiving and distributing submissions of requests for quotes from customers to merchants.

Perkins discloses how to make merchants do your, and their, bidding. The PC Magazine press release discloses a system for helping buyers choose personal computers and manufacturers therefor.

Examiner wishes to make of record that he has seen and considered the supplemental information disclosure statement, document #7, filed July 14, 1999, referring to related applications by the same inventive entity. Examiner also wishes to call Applicant's attention to the fact that Examiner is not in possession of, and has not considered, the non-patent literature documents cited in the information disclosure statement filed May 6, 1999, document #4.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30-5:00, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-1396 for regular communications and 703-308-1396 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Nicholas D. Rosen
Nicholas D. Rosen
November 21, 2000


VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100